

### **III. REMARKS**

#### **Status of the Claims**

Claims 1 and 13 are amended. Claims 1-24 are presented for further consideration. Applicant is pleased to note that claims 10, 11, 22, and 23 are indicated to contain patentable subject matter.

Applicant has noted the Examiner's comments with respect to a broad interpretation of the claims and has amended independent claims 1 and 13 to clarify the novel features of the invention for which protection is sought in this application. In particular, this is done to make the claims more consistent with the patentable subject matter of claims 10, 11, 22, and 23. Although Applicant recognizes the Examiner's position, it believes that it is entitled to protection that is broader than what is stated in allowed claims 10, 11, 22, and 23. These amendments are submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. Applicant submits that such amendments are properly entered under 37 U.S.C. 1.116 and accordingly, Examiner is requested to enter these amendments.

Applicant has considered the Examiner's comments set forth in the Office Action mailed August 20, 2007 and responds in detail below. Reconsideration of the application is respectfully requested in view of the amendments and the following remarks.

#### **The Office Action**

Claims 1-9, 12-21 and 24 stand rejected under 35 U.S.C. 103(a) based on the combined teaching of the reference Durrett and Official Notice. This rejection is traversed on the following grounds:

The combined teaching does not render claims 1-9, 12-21 and 24 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."**

In particular the combined teaching fails to disclose or suggest the following claimed features of independent claim 1, as amended:

**"a plurality of mobile terminals, each mobile terminal being provided with means for acquiring personal content and adapted to be in wireless communication with a telecommunications system, said personal content including at least one of photographs, text, video, speech, calendar information, and location information;.....**

**....in response to said associating step, generating a personalized service, incorporating at least one of said photographs, text, video, speech, calendar information, and location information and using said extracted data associated with said at least a second part of the personal content,"**

Independent claim 13, as amended, has equivalent language.

The reference Durrett fails to teach or suggest the use of a mobile terminal as described in claim 1. The portal device of Durrett is a dumb terminal designed to access the internet through a modem (see column 4, line 66 - column 5, line 2). The capability of the portal device is described succinctly at column 2, lines 25-27, as follows:

**"The base user portal device is essentially useless unless it is connected to a network having at least a virtual disk server."**

The Examiner's reliance on "inherency" and official notice are not supported in the cited reference. The Examiner's attention is also directed to column 6, lines 4-12 in particular the following:

**"These programs would not be resident on local computer 10B but would be obtained when needed and would utilize the non-volatile memory of the access provider computer."**

It is clear from the claims of this application that the personal data is stored in memory on the mobile terminal and that the terminal is fully capable of independent operation. It is equally clear that the portal device of Durrett is not intended to have this capability. There is nothing in Durrett that teaches that the fingerprint ID is stored anywhere in the portal device, but is merely scanned and sent.

The Examiner resorts to inherency at every step in the analysis, while Durrett describes a portal device that is designed for minimal architecture and adjusts the remote system to provide all of its functions. In this analysis, the Examiner is burdening the portal device of Durrett with the precise elements that Durrett has so diligently sought to avoid. Durrett actually teaches away from the Examiner's position.

The amended claims now define the personal content more specifically and it should be clear that fingerprint identification data is not the equivalent of "photographs, text, video, speech, calendar information, and location information. In addition the service of providing secured access, cannot be considered equivalent to a service that incorporates such personal data as specified in the claims of this application. The features of amended claims cannot be found in the cited art by resorting to the doctrine of inherency, as there is nothing in the system of Durrett that describes or suggests these features. The features of the claimed subject matter would not be recognized by persons skilled in the art as necessarily present in the system of Durrett. It is well settled that:

**"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing**

**described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)**

The Examiner also relies on "official notice". Applicant submits that this does not provide the combined teaching with any suggestion of the claimed subject matter. In view of the final nature of the rejection, the use of official notice should only be used in rare circumstances and it has been held that:

**"Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).**

The claimed subject matter cannot be demonstrated to capable of such instant recognition.

These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims. None of the cited references remedy the deficiencies of the primary reference Durrett.

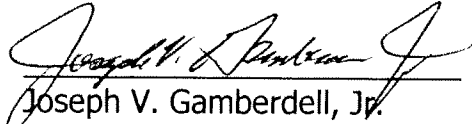
For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

10/502,280

Response to the Office Action mailed August 20, 2007

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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20 November 2007  
Date

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